

Remarks

This is a full and timely response to the outstanding non-final Office Action mailed February 8, 2006.

Claims 13-21 and claims 26-31 remain unchanged. It is believed that no new matter is added by this response.

The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

Rejections under 35 USC § 101

Claims 13, 16 and 26-28 stand rejected under 35 USC § 101. With respect to the 101 rejection, the Office Action, in part, states: "Claims 13, 16 and 26-28 stand rejected under 35 USC § 101" because the claimed invention is directed to non-statutory subject matter.... In each of claims 13, 16 and 26-28, while defining a program, do not define a "computer-readable medium" and is thus non-statutory for that reason...." Office Action, Page 2-3.

Applicant's respectfully disagree that claims 13, 16 and 26-28 are directed to non-statutory subject matter. The MPEP at 2106 IV.B.1(a) States:

Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Claims 13, 16, 26 and 27, taken as a whole, are each directed to a server and not a mere program listing. Accordingly, each of these claims are statutory and the 101 rejection of these claims should be withdrawn.

Claim 28, taken as a whole, is directed to a printing system and not a mere program listing. Accordingly, claim 28 is also statutory and the 101 rejection of claim 28 should be withdrawn.

Rejections under 35 USC § 102

Claims 13-21 and claims 26-31 stand rejected under 35 U.S.C. §102(e) as being anticipated. The Examiner states: "Claim 13-21 and 26-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshino et al. (U.S. Patent Application Number 2001/0042117). Office Action, Page 4.

Applicant respectfully traverses the 102 rejection.

As to a rejection under 102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CAFC) 221 U.S.P.Q. 385. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and *Cool-Fin Elecs. Corp. v. International Elec. Research Corp.*, 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Independent Claim 13 and its dependent Claims 14-21

Independent 13 states:

13. A server, comprising:

- (a) means for receiving a request from a client; and
- (b) means for responding to the request by transmitting a

program of instructions to the client, the program for enabling the client to:

- (i) initiate the printing of a document by a printer;
- (ii) detect if the printer encounters an alert condition while

printing a document; and

(iii) if an alert condition is detected, display a selectable object for initiating a performance by the client of a specified function.

Independent claim 13 is allowable for at least the reason that Yoshino does not disclose, teach, or suggest the features that are highlighted in claim 13 above.

The Examiner appears to take the position that Yoshino, at paragraphs 0055, 0031-0032, 0066-0068, 0077 and 0086-0087, disclose all the highlighted elements of claim 13. Applicant's respectfully disagree.

Yoshino describes a Personal Computer ("PCu") that can connect to a Server (SV) for online support. The Server (SV) can operate to send "support information 110" (in the form of Web Pages) and a "transmission form" 120 to the Personal Computer ("PCu").

Yoshino's Personal Computer ("PCu") appears to be pre-configured to initiate printing of a document. There is no indication that Yoshino's Server (SV) operates to transmit a program [to Yoshino's Personal Computer ("PCu")] that enables Yoshino's Personal Computer ("PCu") to initiate the printing of a document; detect if the printer encounters an alert condition while printing a document; if an alert

condition is detected, display a selectable object for initiating a performance by the client of a specified function.

Moreover, it is respectfully asserted that nowhere does Yoshino disclose a Server that can operate to transmit a program to the Personal Computer (PCu) that enables the PCu to initiate the printing of a document by a printer; detect if the printer encounters an alert condition while printing a document ; detect if the printer encounters an alert condition while printing a document; and if an alert condition is detected, display a selectable object for initiating a performance by the client of a specified function.

Thus, Yoshino's does not anticipate claim 13, and the rejection should be withdrawn.

Because independent claim 13 is allowable over the prior art of record, its dependent claims are also allowable as a matter of law, for at least the reason that the dependent claims 14- 21 contains all features/elements/steps of its respective independent claim 13. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Additionally and notwithstanding the foregoing allowability of claim 13, the dependent claims recite further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. Hence, there are other reasons why this dependent claim is allowable.

For example, claim 21 recites:

21. The server of claim 13, wherein the server is incorporated within the printer.

Nowhere does Yoshino disclose a printer that incorporates the server of claim 13. Yoshino's Server (SV), for example, is an element of the support center and is not embodied within a printer.

Thus, Yoshino's disclosure can not anticipate claim 21, and the rejection should be withdrawn.

Independent Claim 26 and its dependent Claim 27

Independent 26 states:

26. (original) A server, comprising:

apparatus for responding to a pre-defined request received from a client by transmitting a program of instructions to the client, the program for enabling the client to:

- (i) detect if the printer encounters an alert condition while printing a document; and
- (ii) if an alert condition is detected, display a hyperlink for initiating a performance by the client of a specified function for assisting a user in resolving the alert condition.

Independent claim 26 is allowable for similar reasons as discussed above in connection with claim 13. Accordingly, it is respectfully asserted that nowhere does Yoshino describe a server that can operate to serve a program of instructions that enables a client to detect if the printer encounters an alert condition while printing a document. For this reason alone, Yoshino can not anticipate independent claim 26.

Further, nowhere does Yoshino describe a server that can operate to serve a program that enables a client to display a hyperlink for initiating a performance by

the client of a specified function for assisting a user in resolving the alert condition. For this reason alone, Yoshino can not anticipate independent claim 26.

Accordingly, Yoshino does not anticipate claim 26, and the rejection should be withdrawn.

Because independent claim 26 is allowable over the prior art of record, its dependent claim 27 is also allowable as a matter of law, for at least the reason that it contains all features/elements/steps of its respective independent claim 26. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Additionally and notwithstanding the foregoing allowability of claim 26, the dependent claim 27 recites the further feature of: "wherein the program further enables the client initiate the printing of the document by the printer". Nowhere does Yoshino disclose this limitation. Yoshino's Server (SV), for example, does NOT serve such a program to clients.

Accordingly, Yoshino does not anticipate claim 27, and the rejection should be withdrawn.

Independent Claim 28 and its dependent Claims 29-31

Independent 28 states:

28. (original) A printing system, comprising:

(a) a printer operable to print a document and to serve a program of instructions to a client;

(b) a client operable by a user to request the program from the printer, the program enabling the client to:

(i) initiate the printing of a document using the printer;

(ii) if the printer encounters an error condition while printing the document, display a hyperlink for initiating a performance by the client of a specified function to assist the client user in resolving the alert condition.

The Server (SV) described by Yoshino is an element of a support center and is not embodied in a printer. Yoshino makes no mention of a printer that can serve a program to a client. For this reason alone, Yoshino can not anticipate independent claim 28.

Yoshino also makes no mention of a printer that can serve a program which enables a client to initiate the printing of a document using the printer; AND display a hyperlink for initiating a performance by the client of a specified function to assist the client user in resolving the alert condition. For this reason alone, Yoshino can not anticipate independent claim 28.

Because independent claim 28 is allowable over the prior art of record, its dependent claims are also allowable as a matter of law, for at least the reason that the dependent claims 29-31 contains all the features/elements/steps of its respective independent claim 28. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Conclusion

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,
Shell S. Simpson et al.

Date

4/27/06

Hewlett-Packard Company
P.O. Box 272400 M/S 35
Fort Collins CO 80527-2400

By

Matthew L. Wade

Matthew L. Wade
Registration No. 42,206
Telephone: 208 396 5263